UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,815	06/18/2001	Ta-Ching Pong	PONG3002/BEU	9271

23364 7590 07/02/2004

BACON & THOMAS, PLLC
625 SLATERS LANE
FOURTH FLOOR
ALEXANDRIA, VA 22314

EXAMINER	
VU, NGOC K	

ART UNIT	PAPER NUMBER
2611	6

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/881,815	Applicant(s) PONG, TA-CHING	
	Examiner Ngoc K. Vu	Art Unit 2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 January 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8 and 11-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8 and 11-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-8 and 11-15 filed 1/21/04 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

2. Claims **5** and **6** are objected to because of the following informalities:

Claim **5** recites the limitation "said blue-painted portions of the real-life environment" in line 2. It appears that claim 5 calls for the limitation "blue coloring to potions of a real-life environment" as previously cited in claim 4 at line 2. Thus, please change the limitation "said blue-painted portions of the real-life environment" in line 2 of claim 5 to "said blue coloring to portions of the real-life environment", and also change "a method as claimed in claim 3" in line 1 of claim 5 to "a method as claimed in claim 4. Appropriate correction is required.

Claim **6** recites the limitation "said real-life environment" in line 1. It appears that claim 6 calls for the limitation "a real-life environment" as previously cited in claim 4 at line 2. Thus, please change "a method as claimed in claim 3" to "a method as claimed in claim 4". Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 7, 8 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7 and 8 are indefinite because there is no antecedent basis for the limitation "said advertisements" in line 1.

Claim 13 is indefinite because there is no antecedent basis for the limitation "the user's computing device" in line 2.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims **1, 2, 7, 14** and **15** are rejected under 35 U.S.C. 102(e) as being anticipated by Jeannin et al. (US 20020083469 A1).

Regarding **claim 1**, Jeannin discloses a method of delivering advertising *(e.g., 290, 291 – see figure 9)* to a user via composite images *(e.g., 310 – see figure 9)* displayed to the user through a media display device *(viewing device 10 – see abstract; page 2, 0030 and figure 1)* comprising the steps of:

displaying a program *(displaying an audiovisual program, e.g., tennis game – see figure 9)*; and

inserting, while said program is being displayed, an advertisement into a selected portion of the displayed program, said advertisement being displayed in a manner appropriate to the content of the displayed program *(as shown in figure 9, an advertisement, i.e., 290 and/or 291, is inserted into a selected portion of the displayed audiovisual program, the advertisement being*

displayed in a manner appropriate to the content of the displayed audiovisual. For example, the advertisement 290, 291 is placed alongside a tennis court 300 of the displayed tennis program – see figure 9 and page 3, 0033),

wherein said program is an interactive video program, and wherein said advertisement is updated based on responses to a previously inserted advertisement, said responses being submitted by the user via an interface device *(the audiovisual program is interactive video program because the user is allow to interact with the inserted advertisement of that audiovisual program. It is noted that the inserted advertisement comprises only visual data but may also comprise audio and other types of data, is typically not displayed until specifically requested to be displayed. For example, the user may point to and click on the inserted advertisement, e.g., the object of interest, with an interface device, e.g., a pointer device 50. The user's click causes the further information about the object to be accessed and displayed on display 60 – see page 3, 0037).*

Regarding **claim 2**, Jeannin discloses the step of inserting said advertisement comprises the step of merging a simulated image into the program *(e.g., embedding or inserting a simulated object into the audiovisual program – see page 3, 0033).*

Regarding claim **7**, Jeannin discloses the advertisement is updated in real time *(e.g., presenting the further information of the inserted advertisement when the user clicks on the selected object – see page 3, 0037).*

Regarding **claim 14**, Jeannin discloses a system of delivering advertising *(e.g., 290, 291 – see figure 9)* to a user via composite images *(e.g., 310 – see figure 9)* displayed to the user through a media display device *(viewing device 10 – see abstract; page 2, 0030 and figure 1)*, comprising:

means for displaying a program *(displaying an audiovisual program, e.g., tennis game – see figure 9)*; and

means for inserting, while said program is being displayed, an advertisement into a selected portion of the displayed program, said advertisement being displayed in a manner appropriate to the content of the displayed program *(as shown in figure 9, an advertisement, i.e., 290 and/or 291, is inserted into a selected portion of the displayed audiovisual program, the advertisement being displayed in a manner appropriate to the content of the displayed audiovisual. For example, the advertisement 290, 291 is placed alongside a tennis court 300 of the displayed tennis program – see figure 9 and page 3, 0033)*, wherein said program is an interactive video program, and wherein said advertisement is updated based on responses to a previously inserted advertisement, said responses being submitted by the user via an interface device *(the audiovisual program is interactive video program because the user is allow to interact with the inserted advertisement of that audiovisual program. It is noted that the inserted advertisement comprises only visual data but may also comprise audio and other types of data, is typically not displayed until specifically requested to be displayed. For example, the user may point to and click on the inserted advertisement, e.g., the object of interest, with an interface device, e.g., a pointer device 50. The user's click causes the further information about the object to be accessed and displayed on display 60 – see page 3, 0037).*

Regarding **claim 15**, Jeannin discloses the step of inserting said advertisement comprises the step of merging a simulated image into a broadcast program *(e.g., embedding or inserting a simulated object into an audiovisual program – see page 3, 0033).*

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims **3-6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jeannin et al. (US 20020083469 A1) in view of Wilf et al. (US 6,208,386 B1).

Regarding **claim 3**, Jeannin discloses *embedding or inserting the simulated object into the audiovisual program (see page 3, 0033).*

Jeannin does not explicitly disclose using "blue screen" technology for the step of merging.

However, Wilf et al. teach using chroma-key or blue screen technology for electronically replacing a real billboard in a video image display by the replacement billboard. By use of the chroma-key technology there is no requirement to transmit any occlusion data since this can be readily inserted at a receiver and the occlusion inserted in the normal manner *(see col. 3, lines 39-42; col. 4, lines 21-24 and 30-32; col. 5, lines 6-20 and 46-47; col. 14, lines 29-33).*

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Jeannin by using the chroma-key or blue screen technology for replacing a portion of the video image, i.e., real billboard in the video image, by a replacement portion, i.e., replacement billboard, at the receiver as taught by Wilf et al. for the advantage of inserting an image into a video image at the receiver with less cost.

Regarding **claim 4**, the combination teaching of Jeannin and Wilf et al. disclose wherein application of the blue screen technology involves adding blue coloring to portions of a real-life

environment *(Wilf et al. disclose that the billboard to be replaced is blank and is of colour suitable for chroma-key replacement such as blue– see Wilf: col. 5, lines 53-55)*.

Regarding **claim 5**, the combination teaching of Jeannin and Wilf et al. disclose wherein real-life environment is a sports venue *(for example, Jeannin shows a tennis game in figure 9)*, and said blue-painted portions of the real-life environment are areas on which advertisements would normally be displayed, including areas of billboards *(for example, Wilf et al. disclose that in an arrangement within a stadium or other sport venue real billboards with normal advertising material will be situated on one side of the stadium to be viewed by a first plurality of cameras and chroma-key billboards will be situated on another or the opposite side to be viewed by a second plurality of cameras – see col. 5, lines 10-15)*.

Regarding **claim 6**, the combination teaching of Jeannin and Wilf et al. does not explicitly show that a real life environment is a musical event. However, the combination teaching of Jeannin and Wilf et al. is used in a real life environment such as a tennis game wherein advertisements are displayed on background of the event by using blue screen technology *(see Jeannin: figure 9, and Wilf: col. 3, lines 39-42; col. 4, lines 21-24 and 30-32; col. 5, lines 6-20 and 46-47; col. 14, lines 29-33)*.

In view of this, Official Notice is taken that it is well known in the art to use the system as taught by Jeannin and Wilf et al. for a musical event to present advertisements on the background of the stage.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to present advertisements on a background of a stage in a musical event for the desirable benefit of providing the advertisements to a wider range of audiences.

9. Claims **8** is rejected under 35 U.S.C. 103(a) as being unpatentable over Jeannin et al. (US 20020083469 A1) in view of Tanabe et al. (US 20010027559 A1).

Regarding **claim 8**, Jeannin does not explicitly disclose that the advertisement is updated by advertisement sponsor.

However, Tanabe teaches that the advertiser can update the contents of the advertising information any time when the need arises, so that the viewer can view the latest advertising information. Tanabe further discloses that the advertiser can update the contents of advertising information *(see page 3, 0032; page 4, 0059; page 10, 0146).*

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Jeannin by updating the advertisement by advertiser when the need arises as taught by Tanabe et al. to allow the viewer viewing the latest advertising information.

10. Claim **11** is rejected under 35 U.S.C. 103(a) as being unpatentable over Jeannin et al. (US 20020083469 A1) in view of Stautner et al. (US 6,172,677 B1).

Regarding **claim 11**, Jeannin does not explicitly disclose the feature that the user is given the option of performing on-line or off-line transactions in response to the advertisements.

However, Stautner shows in figure 2 a Pizza Hut advertisement including telephone number for the user makes an order anytime at anywhere. The user can select icon 40 to place an order on-line. By selecting icon 40, an automated sequence of events performed by the computer would then extract a proper telephone number from the data base, dial the particular number and place the users in a situation where they are in voice contact with the pizza restaurant or alternatively, provide for an automatic selection of the specifications of their desired pizza *(see figure 2 and col. 5, lines 25-28; col. 6, lines 50-59).*

Therefore, it would have been obvious to one of ordinary skill in the art to modify the system of Jeannin by providing a telephone number in an advertisement for the users to order

the product anytime at anywhere, or automatically dialing that number by selecting an icon to allow the users in voice contact with an operator to make an order as disclosed by Stautner in order to allow the users the option to order the product right away or later in a such convinced manner.

11. Claim **12** is rejected under 35 U.S.C. 103(a) as being unpatentable over Jeannin et al. (US 20020083469 A1) in view of Gautier (US 6,618,858 B1).

Regarding **claim 12**, Jeannin does not explicitly disclose a login process including the steps of determining an identity and location of the user; organizing the identity and location information into a suitable information packet; and storing the packet in the user's computing device or in computing devices located in the premises of the provider.

However, Gautier teaches that when a viewer logs onto services through an advanced set-top-box (ASTB), the viewer enters a TV name which is used to identify that viewer's account or identity locally on the ASTB. The viewer also enters a PIN and a service he/she wants to access. This information is then used on the local ASTB to retrieve a UID. The UID along with other information is transmitted over the network to the MSO. The MSO uses the UID to retrieve any information it needs to process the viewer's requests *(see figure 3; col. 7, lines 21-36 and col. 7-8, lines 61-4)*.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Rosser by including login process as taught by Gautier in order to verify the viewer identification for accessing the service.

12. Claim **13** is rejected under 35 U.S.C. 103(a) as being unpatentable over Jeannin et al. (US 20020083469 A1) in view of Stautner et al. (US 6,172,677 B1) and further in view of Tomsen (US 20020016965 A1).

Regarding **claim 13**, the combination teaching of Jeannin and Stautner et al. does not explicitly disclose the steps of permitting the user to select whether to accept updating of the user's computing device.

However, Tomsen teaches that a television commercial displays a prompt that asks the viewer whether the viewer wishes to "Buy now" or "Buy later". If the viewer clicks the "Buy now" selection in response to the prompt, then additional commands can be sent from the set top box to the participating merchant to allow the viewer to conduct and complete the transaction. If the viewer clicks the "Buy later" selection in response to the prompt, then the transaction is deferred. Deferral of the transaction includes saving information in the set top box (*see page 4, 0034-0037)*.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination teaching of Jeannin and Stautner et al. by permitting the user to select whether to accept updating of the user's computing device, i.e., order an advertised product now or later, as taught by Tomsen in order to allow the viewer begin a transaction to order the advertised product, or save information related to that television commercial in a convenience manner.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 703-306-5976. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VIVEK SRIVASTAVA
PRIMARY EXAMINER

NV
June 21, 2004